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HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

Paper No. 18

In re Application of
SMITH ET AL.
Appl. No.: 09/691,782
Filed: October 19, 2000
For: COVERED STENT
Attorney Docket Number: 760-3 RES

**DECISION DISMISSING
PETITION
37 CFR 1.181**

This is a decision on petitioner's request filed June 6, 2003 (and resubmitted on May 7, 2004 and July 13, 2004) to review the holding of abandonment, mailed April 4, 2003. In view of petitioner's statements, the submission is being treated as a petition under 37 CFR 1.181. No fee is required for this petition.

The petition is dismissed.

A review of the file history indicates that the present application is a reissue of application number 08/720,091, now US Patent Number 5,824,046. A final rejection was mailed June 5, 2002 setting a shortened statutory period of 3 months. The final rejection indicated that claims 1-14 were allowed and claims 15-21 were rejected. Claims 1-14 at the time of the final rejection were identical to claims 1-14 in US Patent Number 5,824,046. Claims 15-21 were added during prosecution of the reissue application. An after-final amendment was submitted on September 9, 2002 with a certificate of mailing dated September 3, 2002. The amendment proposed amending a typographical error from claim 5 of the issued patent (i.e. changing "EPTFE" to "ePTFE"), inserting the implied term "ends" in claim 7 that was omitted from the issued patent, amending claims 15, 19, and 21, and canceling claim 18. The examiner indicated that the amendment would be entered for appeal purposes in the Advisory Action mailed September 25, 2002. Applicant filed a second after-final amendment on November 13, 2002 with a certificate of mailing of November 5, 2002 (with a 2-month extension of time) proposing to cancel claims 15-17 and 19-21. The examiner indicated that the amendment would not be entered because entry of the amendment would result in the situation where there is no error in the patent providing grounds for the reissue application.

An amendment filed at any time after final rejection, but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions (see MPEP 714.13). Since a Notice of Appeal, Appeal Brief and the requisite fees were never filed, the proposed amendment

of September 9, 2002 was never entered. Therefore, the claims 1-14 of record in the present application were always identical to claims 1-14 of the issued patent. So, the Examiner was correct in stating that a proposed amendment that left only the original claims from the issued patent should not be entered because there would be no difference between the patent and the claims in the reissue application.

In arguendo, had the amendment to claims 5 and 7 (amending a typographical error from claim 5 of the issued patent (i.e. changing "EPTFE" to "ePTFE") and inserting the implied term "ends" in claim 7 that was omitted from the issued patent) been presented earlier in prosecution and been entered into the claims of record, these changes would not serve as the basis for an error upon which the reissue could be based. MPEP 1402 states, in part:

In accordance with 35 U.S.C. 251, the error upon which a reissue is based must be one which causes the patent to be "deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." Thus, an error under 35 U.S.C. 251 has not been presented where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. 251. These corrections to a patent do not provide a basis for reissue (although these corrections may also be included in a reissue application, where a 35 U.S.C. 251 error is already present). These corrections may be made via a certificate of correction (see MPEP § 1481).

Therefore, applicant should file a certificate of correction if they want these changes made to the claims of US Patent Number 5,824,046.

Petitioners may file a renewed petition, without fee, addressing the points raised above. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extensions of time under 37 CFR 1.136(a) are permitted. Petitioner may wish to consider filing a petition to revive under 37 CFR 1.137.



Richard A. Bertsch
Richard A. Bertsch, Director
Technology Center 3700